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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,221	07/10/2003	F. Hayden Connor	01430USU/2402	2240

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EXAMINER

KASENGE, CHARLES R

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/616,221

Applicant(s)

CONNOR, F. HAYDEN

Examiner

Charles R Kasenge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahachek U.S. Patent 6,231,196. Referring to claims 1 and 12, Mahachek discloses a process for transferring a photo image to a medium comprising the steps of: converting a photo image into an electronic format (col. 6 and 7, lines 59-67 and 1-15); editing said photo image via a first electronic editor (col. 7, lines 25-42); converting said photo image via a second electronic editor into a format compatible with a computer aided laser system (col. 7, lines 43-53); importing said photo image into a third electronic editor to create a desired cut line; and etching said photo image to a medium via said computer aided laser system (col. 7, lines 54-57).

Referring to claims 2, 3, 13, and 14, Mahachek discloses the process of claim 1, wherein said medium is a wood and the process of claim 2, wherein said wood is in the form of a picture frame (col. 2, lines 38-52).

Referring to claims 4, 5, 15, 16, and 19, Mahachek discloses the process of claim 3, wherein said picture frame has a protruding portion on which the photo image is etched. Mahachek discloses the process of claim 4, wherein said protruding portion overlaps at least a portion of the photograph display area associated with said picture frame (Fig. 18).

Referring to claims 6-9, Mahachek discloses the process of claim 1, wherein said photo image is converted into electronic format by scanning said photo image into a computer (col. 7, lines 1-15). Mahachek discloses the process of claim 1, wherein said first electronic editor enables a user to adjust the contrast, brightness and/or intensity of said photo image as appropriate to improve the quality thereof (col. 2, lines 53-67). Mahachek implicitly discloses the process of claim 1, wherein during said editing step said photo image is converted into an 8-bit grayscale (col. 7, lines 15-42). Mahachek discloses the process of claim 8, wherein said second electronic editor converts said grayscale to a format compatible with said computer aided laser system (col. 7, lines 43-57).

Referring to claims 10, 11, 17, 18, and 20, Mahachek implicitly discloses the process of claim 1, wherein said third electronic editor enables a user to add text to said photo image (col. 2, lines 33-37). Mahachek discloses the process of claim 1, wherein said cut line coincides with features reflected in said photo image (col. 2, lines 15-26). Mahachek discloses the picture frame of claim 19, wherein said etched image is personalized to the preferences of a consumer (col. 2, lines 15-26).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kasenge whose telephone number is 703 305-8592. The examiner can normally be reached on Monday through Friday, 8:30 - 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CK  
August 20, 2004

Jayprakash N. Gandhi  
Primary Examiner 2110  
Technology Center 2800

*JN Gandhi*  
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